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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219077
Party	Plaintiff Tristar Products, Inc.
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Attachments	91219077_MotiontoStrike.pdf(16199 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Tristar Products, Inc. Opposer, v. Telebrands Corp., Applicant.	Opposition No. 91219077 Application Serial No. 86/232781

MOTION TO STRIKE ALL AFFIRMATIVE DEFENSES

Opposer Tristar Products, Inc. ("Opposer") hereby moves pursuant to Fed. R. Civ. P. 12(f) and TBMP § 503 to strike the first, second, third and fourth affirmative defenses set forth in the Answer of Telebrands Corp. ("Applicant") as being improper, immaterial and/or redundant.

MEMORANDUM IN SUPPORT OF MOTION

Section 506.01 of the TBMP provides that the Board may, upon motion or upon its own initiative, "order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." (3d ed. rev. 2011); s*ee also* Fed. R. Civ. P. 12(f).

On this basis, Opposer moves to strike the first affirmative defense as being improper, and the second, third and fourth affirmative defenses as being redundant and/or redundant.

A. Applicant's First Affirmative Defense of Should Be Stricken as Improper

The Answer, first affirmative defense states: "The Amended Notice of Opposition fails to state a claim upon which relief may be granted to Opposer."

Failure to state a claim upon which relief can be granted is not an affirmative defense. *See Harjo v. Pro Football Inc.*, 30 USPQ2d 1828, 1830 (TTAB 1994). Nevertheless, even if it were, the Amended Complaint states a claim upon which relief can be granted. In the Amended Complaint, Count I requests the mark not be registered based on likelihood of confusion under Section 2(d) of the Trademark Act. Count II of Amended Complaint requests that a registration be denied to the Applicant because an undisclaimed portion of the mark is merely descriptive to the goods. Both Sections 2(d) and 2(e) of the Trademark Act, likelihood of confusion and merely descriptive, are grounds that may be raised in an Opposition. *See also* TBMP 309.03(c).

Accordingly, the first affirmative defense should be stricken.

B. Applicant's Second Affirmative Defense of No Likelihood of Confusion Should Be Stricken as Redundant

The Answer, second affirmative defense states: "There is no likelihood of confusion between Opposer's design mark, COPPER WEAR & Design, that is the subject of U.S. Trademark Application Serial No. 85/826741, and Applicant's mark, COPPER HANDS, that is the subject of U.S. Trademark Application Serial No. 86/232781."

The Amended Opposition, para. 17 states: "Applicant's mark, COPPER HANDS, is likely to cause confusion with Opposer's trademark COPPER WEAR based upon a federal registration and/or common law rights, and therefore Applicant's Mark should be refused registration, rendered unenforceable, and/or restricted under Section 2(d) of the Trademark Act."

The Answer, para. 17 states: "Telebrands denies the allegations contained in Paragraph 17 of the Amended Notice of Opposition."

It can be plainly seen that the second defense is duplicative of the Answer to para. 17 and should be stricken.

C. Applicant's Third Affirmative Defenses Should Be Stricken As Redundant

The Answer, third defense states: "Opposer's mark that is the subject of U.S. Trademark Application Serial No. 85/826741 is a design mark that is described as follows: 'The mark consists of the wording COPPER WEAR in grey, with a copper-colored paintbrush-style stroke at the diagonal between the two words.' The colors grey and copper are claimed, but the words COPPER and WEAR are disclaimed. Accordingly, Opposer has no right to the words COPPER WEAR apart from the design mark as shown

in the application. **Applicant's mark does not use any of the design features of Opposer's mark**." (Emphasis added.)

The Applicant's defense is a thinly veiled denial that there is a likelihood of confusion between the marks. As noted above in the discussion of the Applicant has already denied the allegations that there is a likelihood of confusion.

The third defense is plainly duplicative of the Applicant's answer and therefore, should be stricken.

D. Applicant's Fourth Affirmative Defenses Should Be Stricken As Immaterial and Redundant

The fourth affirmative defense in the Answer states "Opposer's alleged common law word mark, COPPER WEAR, is not distinctive and is descriptive of the goods recited in the application." Essentially the Applicant's fourth affirmative defense, pertains to an infringement or unfair competition action rather than to an opposition proceeding and should be stricken as immaterial. The Applicant's fourth defense, namely, no trademark infringement or unfair competition, are only applicable in the context of a civil action based on infringement or unfair competition and not in an opposition proceeding about registration. These defenses are totally immaterial to this proceeding and should be stricken by the Board. The Board has no authority to consider claims trademark infringement under section 32 of the Lanham Act and/or common law unfair competition. *See, e.g., Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768, 1771 n.5 (T.T.A.B. 1994) (Board has no jurisdiction over claims of trademark infringement and unfair competition), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 U.S.P.Q. 162, 163-64 (T.T.A.B. 1984) (unfair competition and Trademark Act § 43(a) claims are outside the

Board's jurisdiction); TBMP § 102.01 (Board "is not authorized to determine the right to use, nor may it decide questions of infringement or unfair competition"). Accordingly, Applicant's fourth affirmative defense should be stricken as immaterial.

Furthermore and as discussed above, the Applicant has already denied that there is a likelihood of confusion between the Opposer's common law COPPER WEAR mark and the Applicant's COPPER HANDS mark. Accordingly, the fourth affirmative defense is redundant.

CONCLUSION

For the foregoing reasons, Applicant's first, second, third and fourth affirmative defenses should be stricken

Respectfully submitted,

Tristar Products, Inc. (Opposer)

Dated: January 23, 2015

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **MOTION TO STRIKE ALL AFFIRMATIVE DEFENSES** has been served on Applicant's counsel, at the following addresses of record, by first class mail, postage prepaid, this 23rd day of January 2015:

Peter D. Murray
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Dated: January 23, 2015

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